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W. Dennis Drehkoff

Name

Signature

DOCKET: CU-1758

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Mitsuo SADO)
SERIAL NO: 09/117,795) Group Art Unit: 1774
FILED: August 13, 1998) Examiner: D. Garrett
TITLE: Releasant for Aqueous Polymer-Type Floor Polish

THE ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

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TRANSMITTAL LETTER

Dear Sir:

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1. Reply Brief
2. Postcard of Receipt

If any credits or fees are due, the Commissioner is authorized to charge our Account No. 12-0400.

Very truly yours,

November 5, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

MITSUO SADO

Serial No. 09/117,795

Group Art Unit: 1774

Filed: August 13, 1998

Examiner: D. Garrett

For: Releasant for Aqueous Polymer-Type Floor Polish

REPLY BRIEF

Honorable Commissioner of Patents and Trademarks
Washington D.C. 20231

Sir:

The following Reply Brief is submitted pursuant to the Examiner's Answer mailed September 5, 2002 following the Appellant's Brief mailed on April 22, 2002, which followed the Notice of Appeal filed on February 21, 2002.

Appellant agrees with the Examiner's statement of facts in paragraphs 1-6 of the Examiner's Answer. Appellant disagrees with the Examiner's interpretation of the grouping of claims of paragraph 7 of the Answer. The dependent Claims 2-4, as shown in Appellant's Brief, are patentable individually and do not stand or fall together. The limitations of the dependent claims recite specific elements that are patentable over the prior art of record, JP 63-069897 (hereinafter "the JP reference"). The specific recitation of the elements of component A is patentable over the JP reference and they do not stand or fall together with Claim 1. Further, the use of alkanolamine for component (C)

and the aqueous dilution of the composition in Claim 1 are also separately patentable over the JP reference and should not stand or fall with the treatment of Claim 1.

Grounds for Rejection

Claims 1-4 have been rejected under 35 USC §103(a) as obvious over the JP reference. According to the Examiner, the JP reference describes a cleaner composition comprising 5-95% of one or more amines of mono-, di-, and triethanol amines, 0.2-5.0% of one or more high boiling point solvents comprising diethylene glycol mono-butyl ether and benzyl alcohol used for removal of heavy dirt attached to hard surfaces. The Examiner further states that the JP reference teaches all components recited in present Claim 1, parts (A)-(C) and that the component amounts taught by the JP reference encompass and/or overlap with the parameters recited in Appellant's Claim 1. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to produce the claimed composition in the resulting proportions of ingredients. The Examiner alleges that each of the claimed components in the claimed weight ranges are disclosed by the JP reference.

Examiner's Response

The Examiner argued in response to the Appellant's arguments that the intended use of a composition is not patentably significant for different intended uses for two otherwise similar products is not a basis for patentable distinction. The Examiner has submitted that the JP reference discloses all components of the appealed claims in the claimed ranges as shown and therefore the cleaning composition of the JP reference

having similar components must be capable of performing the intended use as stated in Appellant's claims.

Appellant has argued that the JP reference teaches away from the present invention by describing a large number of ingredients rather than a specific combination and amounts of ingredients of the present invention and by disclosing the use of ethylene glycol mono-butyl ether, whereas the present invention excludes the use of that substance. The Examiner has disagreed with Appellant's statement that ethylene glycol mono-butyl ether is not excluded from the claims of the present invention. The Examiner states that Appellant's independent Claim 1 uses the word "comprising" which allows for ingredients other than the specifically recited components (A)-(C) such as ethylene glycol mono-butyl ether to be present in the composition.

The Examiner disputes the results of comparative examples shown on page 9 of the application, wherein compositions comprising ethylene glycol mono-butyl ether in place of diethylene glycol mono-butyl ether and triethylene glycol mono-butyl ether and benzyl alcohol are compared. The Examiner stated that the results are not commensurate in scope with the JP reference. The Examiner reiterated that the instant claims do not exclude ethylene glycol from the composition because of the use of the transition term "comprising" in claim 1.

Argument

The Examiner relies on nonanalogous art in rejecting the present claims in view of the JP reference. Rather than suggesting the present invention, the JP reference

teaches away from the present invention by disclosing the use of a composition for removing water insoluble polymers deposited to impart rust resistance to steel plates or the field of printed circuit board manufacturing.

The claims of the present invention relate to aqueous polymer floor polish removers. As noted by the Federal Circuit in *In re Oetiker* 977F.2d 1443, 1444, 24USPQ 2d 1443, 1445 (Fed. Cir. 1992) analogous art is (1) "in the field of the applicant's endeavor", or if not then (2) "reasonably pertinent to the particular problem with which the invention is concerned." The teachings of the JP reference do not meet the requirements of *In re Oetiker*. The JP reference discloses the interchangeable use of ethylene glycol mono-butyl ether and/or diethylene glycol mono-butyl ether in its cleaners, while the presently claimed invention does not use ethylene glycol mono-butyl ether and claims di- or triethylene glycol compounds for use as cleaners. Not only are the intended use of the cleaners of the JP reference and the presently claimed invention separate, the components are also different. One skilled in the art would not be led to the presently claimed invention by the teachings of the JP reference.

The Examiner has stated that the present claims do not explicitly exclude ethylene glycol mono-butyl ether. Appellant disagrees, as stated in its Brief. In the Comparative Examples 1 and 2, the products of the present invention are shown to be superior to products containing ethylene glycol mono-butyl compositions. Logic doesn't follow the claiming of ethylene glycol mono-butyl compositions by Appellant, even if the Examiner refuses to interpret the clear meaning of the specification and claims of the instant application showing the absence of the ethylene glycol mono-butyl ether.

Indeed the wording of the preamble of Claim 1 utilizes the transition term "comprises" with another phrase "as essential components". The term "comprising" in patent law generally allows for additional components beyond those recited. However, when used by Appellant with the phrase "as essential components" the term "comprising" is limited to the recited components which follow. Keeping this in mind while reading the present Claim 1, ethylene glycol mono-butyl ether is excluded from the claim and renders the claim patentable over the JP reference.

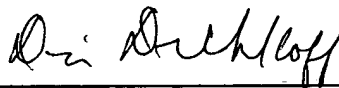
Conclusion

In view of the foregoing, Appellant submits that Claims 1-4 of the present invention meet the requirements of 35 United States Code. Appellant respectfully requests withdrawal of the remaining rejection by the Examiner.

November 5, 2002

Date

Respectfully submitted,



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